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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,908	07/26/2006	Julien Hernandez	004900-273	3883

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EXAMINER

ABU ALI, SHUANGYI

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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08/13/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/562,908	Applicant(s) HERNANDEZ ET AL.	
	Examiner SHUANGYI ABU ALI	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-55 is/are pending in the application.
- 4a) Of the above claim(s) 41-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-40 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 28 - 54 remain for examination wherein claims 28 - 30 are amended, and claims 41 - 54 are withdrawn. Claim 55 is new.

Claim Rejections - 35 USC § 103

The rejection of claims 28 - 31 and 33 - 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. patent No. 3,753,751 to Shannon et al., in view of GB 2256192 as generally set forth in the previous office action mailed 02/24/2009 stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

New-ground Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of U. S. Patent No. 3,753,751 to Shannon et al and GB 2256192 , further in view of U. S. Patent No. 6,468,493 to Chevallier et al.

Regarding claim 30, Shannon et al. disclose a method of making insulation article (reinforced) by route of filter-press technique by dispersing insulation material in water to form slurry, then the slurry is partially dewatered and followed by treatment under heat and pressure. Further, a drying process is carried out to form the insulation material. Shannon et al. disclose that the applied pressure is several hundred pounds per square inch depending upon the nature of the ensuing procedures. (col. 7, line 1-21)

But they are silent that the silica used in the process is precipitated silica. However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use precipitated silica in the above process, motivated by the fact that GB 2256192, also drawn to insulation material, discloses that precipitated silica, which can be used with rutile (an opacifier) and ceramic fiber to form insulation material, is cheap and has improved physical reinforcement (pages 2)

But they are silent that the filtration process is made under a pressure in the range of 0.5-2 bar.

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Chevallier et al., also dawn to precipitated silica, disclose a process of making a silica cake by flittering the silica at a pressure. In the end of the filtration the pressure is in the rage of 3.5-6 bar (the beginning of the filtration is less than 3.5-6 bar). The filter cake is compacted at a pressure of less than 4.5 bar (col. 2, lines 25-30, and col. 4, lines 1-6)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to filtering the silica in a pressure as applicant set forth in claim 30, motivated by the fact that Chevallier et al., also dawn to precipitated silica, disclose that the silica filtered at a pressure of less than 4.5 bar and compacted at a pressure of 6.6 bar has beneficial property such as the enforcing property. (col. 2, lines 25-30, and col. 4, lines 1-6)

Claims 28 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 3,753,751 to Shannon et al , in view of EP 0594469.

Regarding claim 28, Shannon et al. disclose a method of making insulation material (reinforced) by route of filter-press technique by dispersing insulation material in water to form slurry, then the slurry is partially dewatered and followed by treatment under heat and pressure. Further, a drying process is carried out to form the insulation material. Shannon et al. disclose that the applied pressure is several hundred pounds per square inch depending upon the nature of the ensuing procedures. (col. 7, line 1-21)

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But they are silent that the silica used in the process is precipitated silica.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use precipitated silica in the above process, motivated by the fact that EP 0594469, also drawn to insulation material, discloses that precipitated silica can be used with an opacifier to form an insulation article with good thermal insulation property and satisfying strength (pages 1, lines 11-16).

Regarding claim 55, EP 0594469 discloses that the silica weight in the composition is in the range of 65-75%, the opacifying agent amount is in the range of 20-30% and the reinforcement is in the range of 1-10% (page 1)

Response to Arguments

Applicant's arguments filed 05/21/2009 have been fully considered but they are not persuasive.

Applicant argues that Shannon's method of preparing the insulation article can not be made from precipitated silica. The Examiner respectfully submits that Shannon only disclose that their starting material has benefit over other material, which does not mean that their method is not applicable to the silica.

Applicant argues that Shannon disclose of using higher pressure. The Examiner respectfully submits that the higher pressure is used under the condition that the material is alkaline earth silicate, therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to discover the optimum o pressure range for silica to obtain better insulation article by routine experimentation.

Applicant argues that GB 2256192 disclose of using higher pressure. The Examiner respectfully submits that GB'192 is used to show that the precipitated silica and opacifying agent can be used to make the insulation article. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding Chevallier, the applicant argues that the combination would not meet the limitation of claim 32. The Examiner respectfully submits that applicant did not provide the reason why the combination was not proper. Combined teaching of GB'192 and Shannon et al. disclose a process of making an insulation article as applicant set forth in the instant application. And Chevallier disclose that silica with a surface area as applicant set forth in the instant application has good insulation property. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use silica with such surface area in the combined teaching of Shannon and GB'192 motivated by the fact that such silica has good insulation property.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/
Supervisory Patent Examiner, Art Unit 1793

/Shuangyi Abu-Ali/
Examiner, Art Unit 1793